



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 018734/0161

In re application of:

Thomas M. BEHR and David M. GOLDENBERG

Group Art Unit: 1642

Appln. No.: 09/200,791

Examiner: L.R. Helms

Filing Date: November 30, 1998

For: *Methods For Reduced Renal Uptake Of Antibody Fragments And Protein Conjugates*

REPLY BRIEF UNDER 37 CFR §1.193

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This reply brief is responsive to new points of argument raised in the Examiner's Answer, dated August 26, 2003. This Reply Brief is timely filed by the deadline of **October 26, 2003.**

The Examiner raised a new point of argument with respect to In re Johnson, 558 F.2d 1008 (CCPA 1977). The Examiner asserts that In re Johnson is distinct from the present application because in In re Johnson "fifty specific choices were mentioned for the compounds and in the instant application there is no mention of any other proteins except for antibodies and antibody conjugates."¹ Applicants respectfully disagree with the Examiner's assertion.

The court's analysis in In re Johnson did not center around the number of species disclosed in the original application as compared to the number of species encompassed by the claims on appeal. Instead, the court's analysis focused on the fact that the originally filed specification "clearly describes the genus and the two special classes of polymer materials excluded there from."² For example, the court stated that "'the written description' in the

¹ Page 7 of Examiner's Answer.

² In re Johnson, 558 F.2d 1008, 1018 (CCPA 1977).

1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining.”³
Applying the court’s logic to the present application, U.S. Application No. 08/407,899 (hereafter “the ‘899 application”) clearly describes protein conjugates, as well as peptides, small proteins, antibodies, antibody fragments. Therefore, as was the case in In re Johnson, the ‘899 application provides support for the present claims which recite that the protein conjugate is not an antibody or antibody fragment conjugate.

CONCLUSION

For these reasons, and for those propounded in Appellants’ brief on appeal, the Board is requested to reverse the final rejection and send the application to issuance.

Respectfully submitted,

10/21/03
Date

FOLEY & LARDNER
Suite 500, 3000 K Street, N.W.
Washington, DC 20007-5109
(202) 945-6142
(202) 672-5300

Eve L. Frank
Eve L. Frank
Registration No. 46,785

³ In re Johnson, 558 F.2d 1008,1019 (CCPA 1977).